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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/000,366	01/28/1998	MASAHITO HOASHI	HOASHI=2	5189
1444	7590	09/05/2006	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			BECKER, DREW E	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 09/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/000,366

Applicant(s)

HOASHI ET AL.

Examiner

Drew E. Becker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10-14,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-14,17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 3-6, 8, 10-13, and 17-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The application does not appear to provide support for "a kilogram size". Page 4 merely recites "kg units" rather than a size of a single kilogram.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3-6, 8, 10-13, and 17-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 8 recite a "kilogram size". It is not clear whether this refers to a size of a single kilogram, or whether it refers to a size which can be measured in kilograms.

### ***Claim Rejections - 35 USC § 103***

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3-6, 10-13, and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over CA 1213170A in view of Vitkovsky [Pat. No. 4,687,672].

CA 1213170A teaches a method for thawing a frozen ground meat mass by freezing the ground meat at -40°C (page 14, line 21), comminuting the frozen meat in two steps (page 15, lines 4-20), thawing with elevated temperature and without mashing or additives (page 16, lines 15-25), comminuting to a size of 0.125-1.00" or 3-25 mm (page 6, lines 11-12), storing the mass in a plastic bag which is clearly larger than 5 cm (Figure 2, #56 & 58), the meat mass being capable of being measured in kg units, and the conventional size of meat packages being 1-5 lbs (page 1, line 26). CA 1213170A does not specifically recite fish (claim 1), milling while the meat is at a temperature of -15°C or less (claim 1), or the meat mass being 10 kg (claim 17). Vitkovsky teaches a method of milling frozen minced fish (column 9, line 3) to a size of 5-12 mm (column 8, line 13) by freezing it to a temperature of 0 to -196°C (column 6, line 23) and then milling the frozen minced fish (Figure 1, #10 & 35). It would have been obvious to one of ordinary skill in the art to use fish as the meat source of CA 1213170A, in view of Vitkovsky, since both are directed to methods of milling frozen meats, since CA 1213170A already teaches using "other edible animal flesh" (page 6, line 8), since fish meat is edible animal flesh, and since Vitkovsky teaches that minced fish was

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commonly frozen and milled. It would have been obvious to one of ordinary skill in the art to incorporate the milling temperature of Vitkovsky into the invention of CA 1213170A since both are directed to methods of milling frozen meat, since CA 1213170A already included freezing at  $-40^{\circ}\text{C}$  (page 14, line 21), and since Vitkovsky teaches that milling at low temperatures causes the food to become frangible and thus more easily milled (column 1, lines 55-60). It would have been obvious to one of ordinary skill in the art to accumulate 10 kg of the meat in CA 1213170A since CA 1213170A already disclosed storing the mass in plastic bags (Figure 2, #56), since the conventional size of meat packages was 1-5 lbs, or 0.45-2.3 kg (page 1, line 26), since restaurants and other institutions commonly used even larger packages of frozen ground meat (page 2, lines 3 and 12), and since bulk packages of 10 kg would have reduced the amount of packaging needed for a given amount of meat. Regarding particular dimensions or weights, MPEP 2144.04 clearly states that: In re Rose , 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package "of appreciable size and weight requiring handling by a lift truck" where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held

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that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

7. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over CA 1213170A in view of Vitkovsky as applied above, and further in view of Katoh et al [Pat. No. 4,950,494].

CA 1213170A and Vitkovsky teach the above mentioned concepts. CA 1213170A and Vitkovsky do not recite using a pin mixer to stir in additives such as seasoning, starch, sugar, or polyphosphate. Katoh et al teach a method of processing fish paste by mixing in seasoning and starch (column 7, line 5) by using a pin mixer (Figure 1). It would have been obvious to one of ordinary skill in the art to incorporate the mixing of Katoh et al into the invention of CA 1213170A, in view of Vitkovsky, since all are directed to methods of processing ground meat, since Vitkovsky already included fish meat, since additives were commonly known to enhance flavor and other food properties, and since pin mixers were commonly used to add ingredients to ground meat as shown by Katoh et al.

8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Katoh et al in view of CA 1213170A, Vitkovsky, and JP 06133739A.

Katoh et al teach a method of producing kamaboko by molding thawed, ground fish paste (column 6, lines 42-51) and heating the molded fish in two steps to induce gelling (column 6, lines 53-64). Katoh et al do not teach milling frozen, ground fish meat at less

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than -15°C, or heating with electricity. CA 1213170A teaches a method for thawing frozen ground meat by milling the frozen meat (page 15, lines 4-20), a temperature of -40°C (page 14, line 21), and thawing with elevated temperature (page 16, lines 15-25). Vitkovsky teaches a method of milling frozen minced fish (column 9, line 3) to a size of 5-12 mm (column 5, line 13) by freezing it to a temperature of 0 to -196°C (column 6, line 23) and then milling the frozen minced fish (Figure 1, #10 & 35). JP 06133739A teaches a method of producing molded fish paste products by heating with electricity (abstract). It would have been obvious to one of ordinary skill in the art to incorporate the milling of CA 1213170A into the invention of Katoh et al since both are directed to producing ground meat products, since Katoh et al already teaches thawing (column 7, line 1), and since milling prior to thawing would result in reduced thawing time due to the reduction in surface area in relation to volume as taught by CA 1213170A (page 6, lines 13-20). It would have been obvious to one of ordinary skill in the art to incorporate the milling temperature of Vitkovsky into the invention of Katoh et al, in view of CA 1213170A, since all are directed to methods of processing meat, since CA 1213170A already included freezing at -40°C (page 14, line 21), and since Vitkovsky teaches that milling at low temperatures causes the food to become frangible and thus more easily milled (column 1, lines 55-60). It would have been obvious to one of ordinary skill in the art to incorporate the electric thawing of JP 06133739A into the invention of Katoh et al since both are directed to the processing of fish paste products, since Katoh et al already includes heating, and since electric heating was commonly known and used for fish paste products as shown by JP 06133739A. Regarding particular dimensions or

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weights, MPEP 2144.04 clearly states that: In re Rose , 220 F.2d 459, 105 USPQ 237 (CCPA 1955) (Claims directed to a lumber package “of appreciable size and weight requiring handling by a lift truck” where held unpatentable over prior art lumber packages which could be lifted by hand because limitations relating to the size of the package were not sufficient to patentably distinguish over the prior art.); In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (“mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled.” 531 F.2d at 1053, 189 USPQ at 148.). In Gardner v. TEC Systems, Inc., 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

### ***Response to Arguments***

9. Applicant's arguments filed 5/26/06 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., one kg size blocks) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read



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into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). CA 1213170A is directed to a method for milling frozen ground meat in order to promote thawing, while Vitkovsky is directed to a method for comminuting frozen minced fish meat as explained above.


Applicant argues that CA 1213170A comminuted the meat to speed freezing, rather than thawing. However, CA 1213170A clearly teaches milling the frozen meat into small particles prior to thawing (Figure 1, #52 & 54).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E. Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Mon.-Fri. 8am to 4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
DREW BECKER  
PRIMARY EXAMINER

8-31-06